

Application Serial No. 10/523,566
Reply to Office Action of December 27, 2007

PATENT
Docket: CU-4079

REMARKS

In the Office Action, dated December 27, 2007, the Examiner states that Claims 1-13 are pending and Claims 1-13 are rejected. By the present Amendment, Applicant amends the Claims 8 and 13 to correct minor informalities and adds new Claims 14 and 15.

In the Office Action, Claims 1-2, 5-6, 8-9 and 11 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Katafuchi (U.S. 6,159,911). Claims 9-10 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Katafuchi in view of Curtis (U.S. 2003/0220209). Claims 6-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Katafuchi in view of Papay (U.S. 5,652,201). Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Katafuchi in view of Tamoto (U.S. 5,458,807).

The Applicant respectfully disagrees with and transposes the rejections based on Katafuchi. Specifically, the Applicant asserts there are various differences which distinguish Katafuchi from the present invention. Independent Claim 1 of the present application claims the amount of salicylate of "0.005 to 0.5% by mass". Katafuchi discloses in column 1, lines 56-58 "[i]n a preferred embodiment of the present invention there is provided a diesel engine oil composition having a total base number of 15-50 mKOH/g." Based on this description, the amount of salicylate in the composition in terms of the metal element (calcium element) therein is calculated to 0.53 to 1.785% by mass. Therefore, Katafuchi does not teach, suggest or disclose the amount of salicylate of "0.005 to 0.5% by mass" which is claimed in the present application.

Additionally, independent Claim 1 of the present application claims a specific salicylate structure having alkyl substituents in specific positions. In contrast, Katafuchi in column 3, lines 18-27 only discloses obtaining alkaline earth metal salicylate by alkylation of phenol with C8-C18 α -olefin. Katafuchi does not disclose a specific salicylate structure with alkyl substituents in specific positions as claimed in the present application.

Moreover, independent Claim 1 of the present invention claims "a lubricant base oil having a sulfur content adjusted to 0.1% or less by mass." In contrast,

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Katafuchi in column 2, lines 21-23 discloses "[a]s a lube oil base in the diesel engine oil composition of the present invention, there may be used a mineral oil and/or a synthetic oil . . ." Thus, Katafuchi discloses using mineral oil as a base oil, which is not claimed in the present invention.

Likewise, Katafuchi also does not disclose, teach, or suggest that which is claimed in the dependent claims of the present application. As was stated above, Katafuchi does not disclose the specific position of an alkyl substituent, and therefore, the present invention is not obvious in view of Katafuchi.

The Applicant also respectfully disagrees with and transposes the rejections in view of the other cited references. None of the cited references disclose the specific position of an alkyl substituent. Specifically, with respect to the obviousness rejection to Claims 6-7, the Applicant would first like to point out that Claims 2 and 4 of the present application limit salicylate constituent ratio or its structure, and have no relation with anti-wear agent. Therefore, the limitation of Claim 2, which is noted in the Office Action, is the structure of alkylsalicylate and has no relation with trihydrocarbyl phosphite esters in Papay. Furthermore, Papay discloses "sulfur containing additives" as "supplemental antiwear." (column 43, lines 51-58). Therefore, unlike Claim 7 of the present application wherein it is claimed the lubricating oil composition does not contain any sulfur-containing additive substantially, Papay discloses the use of sulfur-containing additives.

In regard to the obviousness rejection to Claim 12, as was stated before Katafuchi does not disclose the specific position of an alkyl substituent, and therefore, the present invention is not obvious in view of Katafuchi. Additionally, Tamoto discloses an engine oil composition containing alkylsalicylate; however, nowhere in the reference is the specific position of the alkyl substituent disclosed. Moreover, the Tamoto also does not disclose the concept that either one of R^1 and R^2 in the general formula (1) is an alkyl group which has 10 to 40 carbon atoms, and the other is a hydrocarbon group which has less than 5 carbon atoms (and may contain oxygen or nitrogen) as is claimed in Claim 12 of the present application.

In the Office Action, Claims 1-4, 8-9, 11, and 13 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Chambard (U.S. Pub. No. 2002/0082176). The Applicant respectfully disagrees with and transposes the rejection based on Chambard. Independent Claim 1 of the present invention claims a specific

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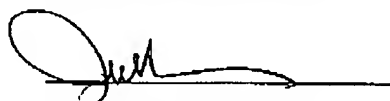
salicylate structure having alkyl substituents in specific positions. Chambard discloses alkyl salicylate having alkyl substituent of C5-C100. However, the reference does not disclose the specific position of the substituent, as is claimed in the present application. Moreover, Chambard does not disclose the ratio of salicylate having substituent at 3- position or at 3- and 5- positions as is claimed in the present invention. Thus, the present invention is also not obvious in view of Chambard and the Applicant respectfully requests the present rejections be withdrawn.

In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

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Date



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